Tedeschi et al. suggest at col. 5, line 11 that a solution of the coating mixture described therein (col. 4, line 65 to col. 5, line 8) may be ***applied to an appropriate substrate*** such as catheter tubes, medical tubing introducers, polymer coated medical wires, stents, ***dilatation balloons***, implants, prostheses, and penile inserts, by conventional coating application methods. Such methods include dipping, spraying, wiping, painting, solvent swelling, and the like (col. 5, lines 8-14). These coatings are applied ***on*** the device.

Nowhere is it taught or suggested by Tedeschi et al. that the coatings described therein be employed in forming a dilatation balloon, nor is there any motivation supplied by Tedeschi et al. to employ the compositions therein for making a dilatation balloon. In cases where a single prior art reference is alleged to render the claimed invention obvious, there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of that reference necessary to reach the claimed invention in order to support the obviousness conclusion. *Sibia Neuroscis., Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

The Office Action asserts that the motivation to employ the coating reagents of Tedeschi et al. in the production of dilatation balloons is found at col. 9, lines 42-48, where the presence of polyurea produced by the reaction of the amine and isocyanate groups is taught to give better biocompatibility and fatigue resistance than polyurethane networks.

Thus, the superior biocompatibility and fatigue resistance to which Tedeschi et al. refers, is relative to polyurethane networks, not to balloon materials. Applicants assert that Tedeschi al. also make no suggestion that the polyurethane networks to which their coatings are compared be employed in the manufacture of balloons either. Thus, the reference is missing an element of the present invention.

Furthermore, the fact that a coating exhibits biocompatibility and fatigue resistance does not suggest to one of ordinary skill in the art that such a coating could be employed to manufacture a balloon because the physical characteristics required for making a balloon versus that of a coating that is applied to a balloon are very different.

In addition to motivation or suggestion, a showing of obviousness requires some reasonable expectation of success. See *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000).

Applicants submit that there is no evidence that a generalized expectation of biocompatibility and fatigue resistance in and of themselves, provides motivation and a reasonable expectation of success in manufacturing a balloon from compositions suggested for use as coatings. The properties described by Tedeschi et al. are not quantitated in a way which would allow a person of skill in the art to predict what balloon properties might be obtained from the same material.

As there is no suggestion, teaching or motivation to employ the coatings described by Tedeschi et al. coupled with a reasonable expectation of success, Applicants respectfully request withdrawal of the rejection of claims 1-8 and 12-19 under 35 U.S.C. §103(a) as being unpatentable over Tedeschi et al.

CONCLUSION

Claims 1-19 are pending in the application. Claims 9-11 have been indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have addressed each of the issues presented in the Office Action. Based on the foregoing arguments, Applicants respectfully request reconsideration and an early allowance of the claims as presented.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: July 31, 2003

By: Lisa Ryan Lindquist
Lisa L. Ryan-Lindquist
Registration No.: 43,071

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001
f:\wpwork\lrl\9178_amd_20030623.doc